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EXAMINER

LIGHTFOOT, ELENA TSOY

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

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10 Ex parte TAKASHI OHIRA

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13 Appeal 2008-4455
14 Application 10/662,330
15 Technology Center 1700

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18 Oral Hearing Held: Thursday, November 6, 2008

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22 Before TERRY J. OWENS, PETER F. KRATZ, and
23 KAREN M. HASTINGS, Administrative Patent Judges

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26 ON BEHALF OF THE APPELLANT:

27
28 HUI CHEN WAUTERS, ESQ.
29 Sughrue Mion, PLLC
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31 Washington, D.C. 20037

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1 The above-entitled matter came on for hearing on Thursday,
2 November 6, 2008, commencing at 1:35 p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,
4 before Jennifer M. O'Connor, Notary Public.

5 THE CLERK: Calendar number 27, Mrs. Wauters.

6 MS. WAUTERS: May I go ahead? Good afternoon, my name
7 is Hui Wauters. I represent Appellant. I assume you're familiar with this
8 case, so I'm going straight to the issues.

9 Claims one and three through six were rejected based on the
10 combination of four references. The primary reference, *Crast*, teaches UV-
11 curable coating to be used on golf balls and *Crast* just broadly teaches that
12 primer or base coat may be used between the top coat and the cover of the
13 ball. So *Crast* does not teach the claimed primer composition comprising an
14 aqueous resin having UV-curable function grooves and the crosslinker.

15 Further, *Crast* does not teach that the primer composition there
16 is not irradiated with UV radiation prior to applying your top coat. Still
17 further, *Crast* does not teach cure the primer layer and the UV-curable paint
18 at the same time. So the Examiner relies on *Jin* as teaching a primer
19 composition as claimed in the present claim one. However, *Jin* teaches --
20 however *Jin* just identifies UV-curable coating as a top coat, so *Jin* does not
21 teach the use of its curable coating as a primer.

22 The teachings of *Crast* and *Jin* do not provide reasonable
23 expectation of success that the coating of *Jin* could be used as a primer in
24 *Crast*, and there's no teaching in either *Crast* or *Jin* of what the adhesion
25 interface might be like between the UV-curable coating of *Jin* and the UV-
26 curable coating of *Crast*.

1 Secondly, *Jin* clearly states that the advantageous effects and
2 benefits of its invention are tied to the coating being nearly 100 percent solid
3 system. *Jin* also criticizes water-born coating being -- suffering from
4 drawback of long curing time. That is, even if you combine *Crast* and *Jin* in
5 the manner proposed by the Examiner, it wouldn't lead to the aqueous resin
6 containing primer composition of claim one because *Jin* does not teach its
7 coating can be formulated as a water-based composition.

8 Since *Jin* expressly states its coating composition to be nearly
9 100 percent solid system, one wouldn't look to the third reference, *Lokai*, to -
10 - which teaches using aqueous radiation curable binder dispersions to reduce
11 the amount of reactive diluents. Reformulating *Jin's* solvent-free coating as
12 a water-based composition would be completely contrary to *Jin's* teachings.

13 In the fourth reference, *Nealon*, the Examiner cites it as
14 teaching cure both the primer and the top coat at same time. However,
15 *Nealon* does not mention UV radiation. The curing in *Nealon* is strictly
16 thermal curing. Further, *Nealon* teaches that the primer was heat dried and
17 cured for 10 minutes in a curing oven and then apply the top coat. Cure the
18 primer and top coat at the same time for six hours.

19 But in the present claim one, it recites that the primer was not
20 irradiated before the -- before top coat is coated, which means the primer
21 was not cured. *Nealon* teaches the primer was dried and cured for 10
22 minutes, so *Nealon's* teachings teach away from the presently claimed
23 invention.

24 JUDGE KRATZ: The last reference you were talking about,
25 *Nealon*, while they do teach that you can have this preliminary curing ,
26 partial curing going on in the primary layer, and then the simultaneous

1 curing of the primary layer with the top layer, that initial curing is not a UV-
2 curing; it's a heat curing. And your claims don't prevent or don't eliminate
3 the possibility of a heat curing going on during -- of the primer layer, right?
4 You could have a heat cure of the primary layer before you have the final
5 curing of the -- UV-curing of the primary layer and the final coat together?

6 MS. WAUTERS: Since the composition of the present
7 invention is UV-curable, so by heating, they are not cured. It says it's not
8 cured. It's not irradiated by the UV radiation before applying the top coat,
9 which means they are not cured. But *Nealon* teaches that their primer was
10 cured, so it teaches away from what claim one recites.

11 JUDGE KRATZ: Is the -- are the coating compositions of
12 *Nealon* different such that they would not be UV-curable?

13 MS. WAUTERS: I think they are not saying it's UV-curable,
14 so they are different from what is claimed. Because the primer of claim one
15 comprises resin having UV-curable functional group, also a crosslinker,
16 while in the primer of *Nealon* it says just resin, there's no crosslinker in the
17 composition.

18 JUDGE KRATZ: The method of application of the primary
19 reference, *Crast*, and I guess the secondary reference, *Jin*, when they put on
20 these primers and the final coat, are they ever the same coat, the same
21 materials used?

22 MS. WAUTERS: You mean the top coat?

23 JUDGE KRATZ: Could the top coat and the primer coat be the
24 same materials?

25 MS. WAUTERS: *Crast* does not teach you what the primer is
26 and *Jin* does not teach using a primer. *Jin* only teaches top coating to be

1 used for the ball. So one wouldn't use coating of *Jin* as a primer of *Crast*.
2 So by combining those references, the present invention wouldn't be arrived.

3 JUDGE KRATZ: Thank you. Any questions?

4 JUDGE OWENS: No more questions.

5 MS. WAUTERS: Okay, thank you. So I can go? I'm done?

6 JUDGE KRATZ: Yes.

7 MS. WAUTERS: Okay, thanks.

8 Whereupon, at 1:45 p.m., the proceedings were

9 concluded.

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